

REMARKS

Applicant has amended Claims 1-3, 6, 8, 15, 22-24, 26-27 and 29, and has added new Claims 31-40 by this paper. Claims 4-5, 7, 9-14, 16-21, 25, 28 and 30 remain unchanged. Claims 1-40 are thus presented for examination. Reconsideration and allowance of all Claims 1-40 in light of the present remarks is respectfully requested. The claim amendments have been made to clarify a perceived ambiguity by the examiner.

Interview

Applicant's representative wishes to thank Supervisory Patent Examiner Thomas G. Black for the personal interview conducted on January 14, 2000. This amendment incorporates concepts developed with the Examiner's assistance during the interview. During the personal interview, as noted on the Interview Summary form, Examiner Black stated that the Official Notice, serving as the basis for a 35 U.S.C. § 102 rejection, will be removed.

Double Patenting Rejection

Paragraph 46 of the Office Action states that "Claims 1-10 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of Claim 5 of prior U.S. Patent No. 5,553,282. This is a double patenting rejection." U.S. Patent No. 5,553,282 is assigned to Taligent, Inc. and has as inventors, Parrish, et al. Applicant believes that the applied patent was miscited and respectfully requests withdrawal of the rejection.

Paragraph 48 of the Office Action states that "Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 5,857,201." Applicant submits herewith a terminal disclaimer to overcome this rejection.

Discussion of the Claim Rejection under 35 U.S.C. § 102(e)

Claims 1-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Reisman, U.S. Patent No. 5,694,546, and by Lotus' cc:Mail product (by Official Notice).

A

The Reisman Patent

The Office Action tries to show that Reisman teaches a session module that is part of the server computer. The text in Reisman at Col. 16, lines 11-49, that was cited by the Examiner for support of the session module, refers to a communication module (36) at a user computer (client), as seen in Figure 1. The steps described in the cited text of Col. 16 are initiated by an application associated with the information product (12), e.g., a CD-ROM containing electronic magazines, located at the client computer and are performed by the client computer. Figure 1 essentially shows a client and a server interconnected by a communications network (20). The server components consist of the remote server (22) and a data storage device (24). The remaining components shown in Figure 1, other than the vendor link (50), are associated with the client, including the operating system service (10), the information product (12), the information transport component (14), the storage device (16) such as a CD-ROM, and the storage device (18) such as a hard drive. While there may be communications software at both the client and the server, Applicant is not claiming the communications software.

Applicant's Claim 1 recites that the server computer comprises a data storage and a session module, and that the portable client device comprises a client database and a communications module. The claims have been amended to recite that the "session module... to non-persistently connect to the communications module and directly manipulate the client database during the connection". The session module at the server directly manipulates the client database at the portable client device. *See* Application in general at pages 9-12, and specifically at page 13, line 27 through page 16, line 15. Such functionality is neither shown nor suggested by the communication module of Reisman.

The Reisman patent also describes use of an "object manifest" to control the information transport operation, in contrast to Applicant's session module at the server, which directly manipulates the client database at the portable client device. The object manifest (48) described by Reisman resides at the client (user) location. This can be seen in Figure 2 where the steps for the information transport operation are shown. The client product application initiates the operation at step 50 and directs that the object manifest is to be obtained by the communications module. The only step performed by the server in this operation is step 60, where fetch objects listed in the object manifest are supplied by the server or send objects are received by the server.

Appl. No. : 220,284
Filed : December 23, 1998

The text at Col. 15, lines 10-54 describes activity that is initiated and is controlled by the client and not the server. The object manifest is described at Column 15, lines 16-23:

Communications module 36 uses a setup ID number specified through API 40 or 43, selects which setup to use for a call, calls remote server 22 using protocol 38, and in a preferred embodiment, sends an object manifest comprising a send object list, a fetch object list or both. Such manifest is created under control of user interface 28 from a pre-existing set of choices supplied with the product or obtained during previous update operations, or both.

Applicant claims a server computer comprising a session module. The claims also require that the session module "to non-persistently connect to the communications module and directly manipulate the client database during the connection from time to time". Unlike Applicant's claims, Reisman's object manifest is stored at the user computer and is acted on by the communications module of the user computer. The object manifest may direct that fetch objects are to be supplied by the server or that send objects are to be received by the server. The Reisman patent does not show a session module at a server that directly manipulates a client database during a non-persistent connection. Accordingly, in view of the above, it is submitted that Claims 1-30 are clearly distinguished from the cited art and are patentable.

Lotus cc:Mail

Applicant respectfully traverses the rejection of Claims 1-30. Applicant is unaware of any statute or PTO rule that allows the Examiner to reject a claim under 35 U.S.C. § 102 based on personal knowledge. In addition, the statutory recitation of § 102(e) appears inapposite to the commercial product reference. If the Examiner has located a reference itemizing the elements of Applicant's claimed invention, then Applicant respectfully requests production of the same. Otherwise, the apparent claim rejections must be withdrawn. (Official notice cannot be taken in a § 102 rejection and recitation of M.P.E.P. § 2144.03 clearly refers to such notice being used in an "obviousness rejection" in conjunction with a reference which would arise from 35 U.S.C. § 103).

New Claims

Applicant has added new dependent Claims 31-32, 33-34, 35-36 and 37-38 to further limit independent Claims 1, 11, 22 and 29, respectively, and new Claims 39-40 to further define the

Appl. No. : 220,284
Filed : December 23, 1998

scope of protection to which the present novel invention is entitled. New Claims 31-38 further define the data storage, and the connection between the portable client device and the server. Databases are described at pages 3 and 10-12 of the present patent application, and wireless connections are described at pages 2-3 and 9-10. New independent Claim 39 is similar to Claim 1 except that the last element has been rewritten to emphasize a wireless connection between the session module and the communications module of the present invention. New independent Claim 40 is similar to Claim 1, and includes aspects of Claim 1 of U.S. Patent No. 5,857,201 as discussed during the personal interview. New Claims 31-40 are distinguished from the disclosure of the cited art and are therefore also deemed patentable.

Conclusion

By this amendment, Applicant has amended the claims and has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-40 of the above-identified application are in condition for allowance. However, if the Examiner finds any further impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1/26/00

By: _____

John M. Carson
Registration No. 34,303
Attorney of Record
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(619) 235-8550